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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ISOM, JOHN W

ART UNIT	PAPER NUMBER
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2447

NOTIFICATION DATE	DELIVERY MODE
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07/23/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/550,895	Applicant(s) FUJIWARA ET AL.	
	Examiner John Isom	Art Unit 2447	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,10-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8,10-14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In the amendment received April 8, 2009 (the "amendment"), Applicant has amended claims 7 and 13; and canceled claims 9 and 15.

Claims 7, 8, 10-14 and 16-18 are pending.

Response to Arguments

2. Applicant's arguments in the amendment, with regard to the rejection of claims 7, 8, 10, 11, 13, 14, 16 and 17 under 35 USC 103(a) as being unpatentable over Seifert (US Pub. No. 20040068543) in view of Malik (US Pub. No. 20020065891), have been fully considered but they are not persuasive.

In the amendment, Applicant argues that each of claims 7 and 13 is not unpatentable over Seifert in view of Malik, because Seifert in view of Malik does not disclose or suggest accepting "only an address containing the partial address registered in the storing unit from the input unit [or means] by inhibiting an input of an address containing no partial address registered in the storing unit," as recited in each of claims 7 and 13.

In response, the examiner traverses and offers the following argument and evidence in support of the traversal:

Each of claims 7 and 13 is unpatentable over Seifert in view of Malik, because Seifert in view of Malik teaches accepting "only an address containing the partial address registered in the storing unit from the input unit [or means] by inhibiting an input of an address containing no partial address registered in the storing unit," as recited in each of claims 7 and 13.

Malik is relied upon as teaching the limitations instantly at issue. Seifert teaches the remaining limitations of the claims at issue.

Malik teaches an e-mail communications system according to a first embodiment which includes an e-mail header interceptor/parser 21 and a domain name checker 22 (Figure 2; [0030]) that operates on an e-mail server ([0050]) to check e-mail domain names (Figure 5; [0037]). When a user attempts to send an e-mail communication, the checker 22 receives the email from the interceptor/parser 21 ([0031]), extracts the domain name from the proposed recipient's e-mail address in step 52, and checks the provided domain name in step 53 ([0037]). If a domain name database in the email server contains the provided domain name, the e-mail server processes the email in step 54, and forwards the e-mail along an Internet gateway for transmission in step 55 ([0037]). If the domain name database does not detect the extracted domain name in step 53, the system provides a prompt to the user in step 56 to either confirm the e-mail address, correct the e-mail communication or cancel delivery, in steps 58, 59 and 60, respectively ([0038]).

Malik further teaches a second embodiment which includes a client-side e-mail communications system 61 which includes e-mail messaging software 64 which

Art Unit: 2447

includes checker software 71 to detect incorrect or invalid e-mail addresses in outgoing e-mail communications (Figure 6; [0043]). If an e-mail address is present in an address directory memory, the e-mail messaging software 64 processes the e-mail communication in step 93 and transmits the e-mail to the LAN, to the e-mail server, and on to the Internet gateway in step 94 ([0048]). If the e-mail address is not present in the address directory memory, the checker 71 generates a prompt in step 95. In response to the prompt, the user can either choose in step 96 to confirm the provided e-mail address in step 97, provide a corrected e-mail address in step 98, or cancel delivery of the message in step 99. If the user confirms that the provided e-mail address is correct, the checker then processes the e-mail communication as described with reference to step 93 ([0049]).

Malik further teaches that the e-mail domain name checker that operates on the e-mail server and the e-mail address checker that operates on user computers can be utilized in combination. Furthermore, the domain name checker 22 can be installed within each user computer ([0050]).

The foregoing facts collectively imply that, where the domain name checker and domain name database are installed within each user computer ([0050]), and the domain name database does not detect the extracted domain name as in step 53, then the email is not processed as in step 93 and is not transmitted to the LAN or e-mail server or Internet gateway as in step 94 ([0048]), unless the user either confirms or corrects the e-mail address, or cancels delivery.

The foregoing facts collectively teach the limitations at issue. Specifically, the fact that the email with address, received from the interceptor/parser 21, is transmitted only if the domain name extracted from the address is in the database ([0037]), teaches “accepting only an address containing the partial address registered in the storing unit from the input unit”.

Furthermore, the *domain name* extracted from the address, teaches a “partial address”. A *domain name in the domain name database* teaches a “partial address registered in the storing unit”. The fact that a *domain name extracted from an address is not found in the database*, teaches “an address containing no partial address registered in the storing unit”. The *transmitting of an email with an address to a LAN/server/gateway*, teaches “an input of an address” to a LAN/server/gateway. The fact that an email *is not transmitted*, teaches “inhibiting an input”. Thus, the fact that an email with address is not transmitted to a LAN/server/gateway if a domain name extracted from the address is not found in a database, teaches “inhibiting an input of an address containing no partial address registered in the storing unit”.

Thus, Malik teaches “accepting only an address containing the partial address registered in the storing unit from the input unit by inhibiting an input of an address containing no partial address registered in the storing unit”.

Based on Seifert in view of Malik, it would have been obvious to a person having ordinary skill in the art at the time Applicant’s invention was made, to combine the teaching of Malik with the claimed subject matter as taught by Seifert, in order to provide for improved and efficient e-mail communications (see Malik at [0051]).

Thus, Seifert in view of Malik teaches accepting "only an address containing the partial address registered in the storing unit from the input unit [or means] by inhibiting an input of an address containing no partial address registered in the storing unit," as recited in each of claims 7 and 13. For these reasons, each of claims 7 and 13 is unpatentable over Seifert in view of Malik. Accordingly, the instant rejection is continued herein.

Claim Objections

3. Claims 7 and 13 are objected to because of the following informalities:
- In the 5th line of claim 7, please amend "data;" to "data; and".
 - In the 8th line of claim 7, please amend "a receiving end" to "a said receiving end".
 - In the 4th line of claim 13, please amend "data;" to "data; and".
 - In the 7th line of claim 13, please amend "a receiving end" to "a said receiving end".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **7, 8, 10, 11, 13, 14, 16 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Seifert** (US Pub. No. 20040068543) in view of **Malik** (US Pub. No. 20020065891).

With regard to claim **7**, Seifert teaches: A data transmitting apparatus which transmits data, comprising:

a controller capable of performing operations of:

registering a partial address that is in common with a plurality of addresses in a storing unit (i.e., group data strings are used to define which incoming e-mails are to be accepted and/or which out-going e-mails are to be transmitted by the e-mail server and/or e-mail client operating on the e-mail user's behalf, wherein group data strings are from at least one of the "From:", "To:", "Subject:" and "Message:" fields of the e-mail under consideration; for example, data strings of one group identify one or more remote e-mail users and/or remote domain names from which e-mail is always to be accepted ([0011], [0013])), among unique addresses that are receiving ends of data (i.e., an e-mail processor comprises means for storing one or more data groups, each group consisting of from none to a plurality of group data strings ([0011]));

restricting data transmission to the addresses that contain the partial address registered in said storing unit (i.e., the processor can provide the administrator in an organizational operating environment with additional controls to determine which incoming e-mails should reach the intended recipient, and which e-mail messages from within the organization are acceptable for transmission ([0012])); and

an input unit for inputting an address of a receiving end (i.e., means of a keyboard, mouse, voice recognition software, etc., are used to generate commands necessary to interact with the communication system ([0031])).

Malik teaches: wherein said controller is further capable of performing an operation of accepting only an address containing the partial address registered in the storing unit from the input unit (i.e., a domain name checker 22 (Figure 2; [0030]) receives an outgoing email with an outgoing address from an e-mail header interceptor/parser 21 ([0031]), and transmits the email to a LAN/server/gateway only if a domain name extracted from the address is in a domain name database (Figure 5; [0037])) by inhibiting an input of an address containing no partial address registered in the storing unit (i.e., the email with address is not transmitted to the LAN/server/gateway if the domain name extracted from the address is not found in the database, unless the user subsequently either confirms or corrects the e-mail address, or cancels delivery ([0038]), *in order to provide for improved and efficient e-mail communications* ([0051])).

Based on Seifert in view of Malik, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made, to combine the teaching of Malik with the subject matter as taught by Seifert, in order to provide for improved and efficient e-mail communications.

With respect to claim 8, Seifert further teaches said controller further capable of interrupting data transmission, when a received address contains no partial address

Art Unit: 2447

registered in said storing unit (i.e., the processor can include means for permitting the transmission of e-mail meeting the authorization criteria defined by the group data strings for authorizing the transmission of e-mail, and for rejecting the e-mail if none of those criteria are met ([0014])).

The limitations of claim **10** are rejected in the analysis of claim 7 above, and the claim is rejected on that basis.

With respect to claim **11**, Seifert teaches said addresses are e-mail addresses, and said partial address is a domain except for a user name (i.e., an "e-mail address" is typically the username separated from the domain name by the symbol, "@" ([0007])).

The limitations of claim **13** are rejected in the analysis of claim 7 above, and the claim is rejected on that basis.

The limitations of claim **14** are rejected in the analysis of claim 8 above, and the claim is rejected on that basis.

The limitations of claim **16** are rejected in the analysis of claim 10 above, and the claim is rejected on that basis.

The limitations of claim **17** are rejected in the analysis of claim 11 above, and the claim is rejected on that basis.

6. Claims **12 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Seifert in view of Malik, and further in view of **Nishida et al.** (US Pat. No. 6972858) (or “Nishida”).

With regard to claim **12**, Seifert in view of Malik teaches: The data transmitting apparatus according to claim 7 (see discussion above). Nishida teaches: an Internet facsimile apparatus that transmits image data (i.e., where a receiver side has Internet facsimile capabilities, an IFAX processing section transmits image data as an E-mail over the Internet (Abstract), *in order to automatically recognize whether or not a receiver side has IFAX functions*). Based on Seifert in view of Malik and further in view of Nishida, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made, to combine the teaching of Nishida with the claimed subject matter as taught by Seifert in view of Malik, in order to automatically recognize whether or not a receiver side has IFAX functions.

The limitations of claim **18** are rejected in the analysis of claim 12 above, and the claim is rejected on that basis.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Isom whose telephone number is (571)270-7203. The examiner can normally be reached on Monday through Friday, 9:30 a.m. to 6:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Hwang can be reached on (571)272-4036. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. I./
Examiner, Art Unit 2447
7/7/2009

/Joon H. Hwang/
Supervisory Patent Examiner, Art Unit 2447